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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,268	11/30/2000	Rabindranath Dutta	AUS920000344US1	5226

7590 04/19/2006
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EXAMINER

LEE, PHILIP C

ART UNIT PAPER NUMBER

2152

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/726,268

Applicant(s)

DUTTA, RABINDRANATH

Examiner

Philip C. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-7, 9-13, 15-19, 21-25, 27-31 and 33-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-7, 9-13, 15-19, 21-25, 27-31 and 33-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. This action is responsive to the amendment and remarks filed on January 30, 2006.
2. Claims 1, 3-7, 9-13, 15-19, 21-25, 27-31 and 33-36 are presented for examination.
3. The text of those sections of Title 35, U.S. code not included in this office action can be found in a prior office action.

Claim Rejections – 35 USC 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1, 3, 7, 12-13, 15, 19, 24-25, 27, 31 and 36 are rejected under 35 U.S.C. 102(a) as being anticipated by International Business Machines Corporation, Research Disclosure, Research Disclosure Database Number 438161 (hereinafter IBM).

6. As per claims 1, 13 and 25, IBM taught the invention as claimed for rendering network addresses of files capable of being downloaded over a network on an output device on an output device, comprising:

generating a list of previously accessed network addresses (page 2, paragraph 2);

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for each listed network address, determining a time to download a page and any embedded files in the page from the network address over the network in response to downloading the page and any embedded files from the network address (page 2, paragraph 2);

storing each determined time with the network address for which the time was determined (page 2, paragraph 2);

determining an access time indicator for the network addresses based on the determined times stored with the network addresses, wherein the determined access time indicator is capable of indicating at least two different access times with respect to one network address (page 2, paragraph 2) (i.e. showing how many seconds it took for the user download a page, e.g. 60 seconds, 50 second, etc.); and

rendering the access time indicator when rendering the page identifications on the output device (page 2, paragraph 2).

7. As per claims 12, 24 and 36, IBM taught the invention as claimed in claims 1, 13 and 25 above. IBM further taught wherein rendering the access time indicator when rendering the processed network address further comprises:

accessing a list of selected network addresses (page 2, paragraph 2)

determining the access time indicator for each of the network addresses in the list of selected network addresses based on the stored determined times for each network addresses (page 2, paragraph 2); and

rendering the determined access time indicator with each network address in the list of selected network addresses (page 2, paragraph 2).

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8. As per claims 3, 15 and 27, IBM taught the invention as claimed in claims 1, 13 and 25 above. IBM further taught wherein the rendered access time indicator comprises an access time rendered with the network address (page 2, paragraph 2) (i.e. a link took 60 seconds to download)

9. As per claims 7, 19 and 31, IBM taught the invention as claimed in claims 1, 13 and 25 above. IBM further taught wherein the determined times are further based on a time to render the downloaded page as output on the display monitor (page 2, paragraph 2) (i.e. how many seconds it took for the user download a page last time should be displayed)

Claim Rejections – 35 USC 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 4, 6, 16, 18, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over IBM in view of Barrett et al, U.S. Patent 5,727,129 (hereinafter Barrett et al).

12. Barrett et al was cited in the last office action.

13. As per claims 4, 16 and 28, IBM taught the invention as claimed in claims 1, 13 and 25 above. IBM did not teach altering the display of the network address on the display monitor.

Barrett et al taught wherein the output device comprises a display monitor, wherein rendering the network address comprises displaying the network address on a display monitor and wherein rendering the access time indicator comprises altering the display of the network address on the display monitor (col. 8, lines 49-61; col. 10, lines 53-64).

14. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of IBM and Barrett et al because Barrett et al's teaching of altering the display of the network address would increase the efficiency of IBM's systems by providing network addresses to be display in a ranked order to minimize the time of search.

15. As per claims 6, 18 and 30, IBM taught the invention as claimed in claims 1, 13 and 25 above. IBM did not teach a network address included in the page to display within the displayed page. Barrett et al taught wherein the output device comprises a display monitor (col. 6, lines 59-61), wherein the file accessed from the network address comprises a page to display on the display monitor, wherein the network address to render comprises a network address included in the page to display within the displayed page (col. 8, lines 49-61; col. 10, lines 19-27).

16. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of IBM and Barrett et al because Barrett et al's teaching of a network address included in the page to display within the displayed page would increase the user's alertness by providing the user a notification of the network address of the web page being visited.

17. Claims 5, 9, 17, 21, 29 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over IBM and Barrett et al in view of Barrick Jr. et al, U.S. Patent 6,625,647 (hereinafter Barrick).

18. Barrick was cited in the last office action.

19. As per claims 5, 17 and 29, IBM and Barrett et al taught the invention substantially as claimed in claims 4, 16 and 28 above. IBM and Barrett et al did not teach the access time indicator comprises a color. Barrick taught wherein the access time indicator comprises a color in which to display the network address on the display monitor (col. 8, lines 7-17).

20. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of IBM, Barrett et al and Barrick because Barrick's teaching of colored access time indicator would increase the user's alertness in IBM's and

Barrett et al's system by allowing a user to avoid the previously visited link with color indicating a slow web source.

21. As per claims 9, 21 and 33, IBM and Barrett et al taught the invention substantially as claimed in claims 6, 18 and 30 above. IBM and Barrett et al did not teach calculating an expected access time from the stored determined times. Barrick taught wherein generating the list of previously accessed network addresses with access time ratings comprises:

calculating an expected access time from the stored determined times for each network address (see Barrett, col. 5, lines 35-67; see Barrick, col. 2, lines 10-18; col. 8, lines 7-17); and

determining an access time rating from the expected access time, wherein the access time indicators are determined for network addresses from the access time ratings for the network addresses (see Barrick, col. 8, lines 7-17).

22. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of IBM, Barrett et al and Barrick because Barrick's teaching of calculating an expected access time would increase the user's alertness in IBM's and Barrett et al's system by allowing a user to avoid the previously visited link with an expected access time of a slow web source.

23. Claims 11, 23 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over IBM in view of Schneider, U.S. Patent 6,760,746 (hereinafter Schneider).

24. Schneider was cited in the last office action.

25. As per claims 11, 23 and 35, IBM taught the invention as claimed in claims 1, 13 and 25 above. Although IBM taught wherein rendering the access time indicator when rendering the processed network address comprises:

determining the access time indicator for each of the determined network addresses in the set based on the stored determined times for each network address (page 2, paragraph 2);
and

rendering the determined access time indicator for each network address with the network address in a list of network addresses (page 2, paragraph 2), however, IBM did not teach selecting one of the rendered network addresses determined from the list of previously accessed network addresses that begin with the received characters. Schneider taught a system comprising:

receiving characters of a network address a user inputs into an address field displayed on the output device (col. 7, lines 7-20);

determining a set of network addresses from the list of previously accessed network addresses that begin with the received characters (col. 7, lines 7-20); and

wherein a user is capable of selecting one of the rendered network addresses to substitute for the received characters to enter into the address field (col. 7, lines 7-20).

26. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of IBM and Schneider because Schneider's teaching of selecting one of the rendered network addresses determined from the list of previously accessed network addresses that begin with the received characters would increase the efficiency by providing user with candidates of match URLs based o received characters without the need for users to complete entry of the fully-resolved URL.

27. Claims 10, 22 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over IBM and Barrett et al in view of Killian, U.S. Patent 6,438,592 (hereinafter Killian).

28. Killian was cited in the last office action.

29. As per claims 10, 22 and 34, IBM and Barrett et al taught the invention substantially as claimed in claims 6, 18 and 30 above. IBM and Barrett et al did not specifically detailing the web page. Killian taught wherein the page is implemented in a markup-language including tagged elements, further comprising:

generating a document object including nodes for the tagged elements (col. 12, lines 54-62);

generating a node for each network address included in the page (col. 12, lines 54-62);

and

generating an attribute for each network address node implementing the access time indicator determined from the network address, wherein the page is rendered from the document object (See Barrick, col. 8, lines 7-17).

30. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of IBM, Barrett et al and Killian because Killian's teaching of the page with tagged element would increase the field of use in their systems.

31. Applicant's arguments with respect to claims 1, 3-7, 9-13, 15-19, 21-25, 27-31 and 33-36, filed 06/10/05, have been fully considered but they are not persuasive.

32. In response to point (1), the declaration under 37 CFR 1.131 filed January 30, 2006 is insufficient to overcome the rejection of International Business Machines Corporation, Research Disclosure, Research Disclosure Database Number 438161 (hereinafter IBM) under 35 USC § 102(a) as set forth in the last Office action mailed on August 25, 2005 because it fails to establish conception coupled with due diligence.

I. General Considerations.

a. See MPEP § 715.07(a). Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence.

b. See also MPEP § 2138.06. The diligence of attorney in preparing and filing patent application inures to the benefit of the inventor. Conception was established at

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least as early as the date a draft of a patent application was finished by a patent attorney on behalf of the inventor. Conception is less a matter of signature than it is one of disclosure. Attorney does not prepare a patent application on behalf of particular named persons, but on behalf of the true inventive entity. Six days to execute and file application is acceptable. *Haskell v. Coleburne*, 671 F.2d 1362, 213 USPQ 192, 195 (CCPA 1982). See also *Bey v. Kollonitsch*, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986) (Reasonable diligence is all that is required of the attorney. Reasonable diligence is established if attorney worked reasonably hard on the application during the continuous critical period. If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient. Work on a related case(s) that contributed substantially to the ultimate preparation of an application can be credited as diligence.).

II. Conception coupled with diligence.

Applicant attempts to establish prior invention by showing Conception with diligence of the invention just prior to October 2000, the publication date of International Business Machines Corporation, Research Disclosure, Research Disclosure Database Number 438161 (hereinafter IBM). In paragraph 2 of the declaration, applicant refers to an invention disclosure form No. AUS8-1999-1468. In particular paragraph 2 states:

- "a) I submitted IBM Invention Disclosure Form No. AUS8-1999-1468, attached as Exhibit A hereto, which describes the invention described and claimed in the subject application.
- b) Each of the dates deleted from Exhibit A is prior to October 2000
- c) I worked diligently with a patent attorney to file the above patent application from at least just prior to October, 2000 to the filing date of the application on November 30, 2000."

Applicant is relying on the submitted documents which purportedly describe the invention for Conception with diligence. At most, the documents may be used to support conception of an invention. They cannot establish diligence because, as noted above, a mere pleading of working diligently just prior to October 2000 to the filing data of the application on November 30, 2000 is not reasonable diligence without showing evidence of facts to establish diligence.

Accordingly, Applicant has not met the burden of showing prior invention.

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33. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Lee whose telephone number is (571) 272-3967. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Philip Lee

 **JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100**